

U.S. Patent Application Serial No. **10/082,089**
Amendment dated June 17, 2004
Reply to OA of **April 1, 2004**

REMARKS

Claims 8 and 12-17 are pending in this application. Claims 1-4, 6-7 and 10-11 have been canceled without prejudice or disclaimer. Claims 13-14 have been newly added. Claim 8 has been amended. The applicants respectfully submit that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated **April 1, 2004**.

Support for the amendment to claim 8 may be found in the specification as follows. Formula 1 was recited in original claim 1, and the particular recitation is supported by page 7, lines 8 to 20, of the specification. The phase inversion accelerator is supported by claims 10 and 11, and the compounds which may be the accelerator are disclosed on page 37, lines 1 to 23, of the specification. The limitation of the binder resin to a polyester resin in claim 8 is based on claim 6.

Newly added claims 13 and 14 are based on page 18, line 24, to page 21, line 5.

Newly added claims 15 to 17 are based on canceled claims 2 to 4.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office action paragraph no. 5)

The rejection is moot in view of the cancellation of claims 1-4, 6 and 7 without prejudice or disclaimer.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over

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U.S. 6,063,537 (Nakamura) combined with U.S. 2002/0058193 A1 (Tosaka), as evidenced by American Chemical Society (ACS) File Registry Nos. 56396-10-2, 6448-96-0, and 122225-06-8.
(Office action paragraph no. 7)

The rejection is moot in view of the cancellation of claims 1-4, 6 and 7 without prejudice or disclaimer.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura combined with U.S. 2002/0037466 A1 (Kanbayashi). (Office action paragraph no. 8)

The rejection is moot in view of the cancellation of claims 1-4, 6 and 7 without prejudice or disclaimer.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 6,265,125 B1 (Anno) combined [with] Tosaka, as evidenced by ACS File Registry Nos. 56396-10-2, 6448-96-0, and 12225-06-8. (Office action paragraph no. 9)

The rejection is moot in view of the cancellation of claims 1-4, 6 and 7 without prejudice or disclaimer.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with Kanbayashi. (Office action paragraph no. 10)

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The rejection is moot in view of the cancellation of claims 1-4, 6 and 7 without prejudice or disclaimer.

Claims 8 and 10-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with Tosaka, as evidenced by the ACS File Registry Nos. 56396-10-2, 6448-96-0, and 12225-06-8, as applied to claim 1 above, further combined with U.S. 6,183,924 B1 (Nomura). (Office action paragraph no. 11)

The rejection of claims 10 and 11 is moot in view of the cancellation of these claims without prejudice or disclaimer. The rejection of claims 8 and 12 is overcome by the amendment to claim 8.

The Examiner states that Anno does not disclose making its toner as in claims 8 and 10-12, although Anno does generally disclose that the toner can be obtained by emulsion dispersion granulation in column 5, line 65. Nomura is cited for disclosing an emulsion dispersion granulation method that provides toner particles having a degree of roundness of not less than 0.97.

In the amendment, claim 8 is amended to replace the recitation that the organic pigment is represented by one of Formulas 3, 4 and 6-9, with the recitation that the organic pigment is represented by Formula 1. Claim 8 is also amended to recite the presence of a phase inversion accelerator, which may be one of the alcohol solvents recited in the claim.

That is, claim 8, as amended, no longer recites formulas (3), (4) and (6), which were indicated as being disclosed in Tosaka.

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Moreover, Anno and Tosaka do not disclose a phase inversion accelerator and do not suggest such solvents having a phase inversion acceleration function.

In the method of claim 8 as amended, a powered toner having a preferable average particle diameter and particle size distribution can be easily produced by employing the phase inversion accelerator.

In the present invention, a mixture containing a polyester resin and an organic pigment which may be added to organic solvents, and an aqueous medium are mixed under the presence of base and phase inversion accelerator.

However in Nomura, the combination of a phase inversion accelerator and a polyester resin is not disclosed. Nomura does not recognize the effect of phase inversion accelerator.

In the present invention, the forming of a suspension wherein the mixture in the form of particles (droplets) is suspended in the aqueous medium is observed and this results in a powdered toner having a preferable average particle diameter and particle size distribution being easily produced.

Applicants therefore submit that claims 8 and 12, as amended, are novel and non-obvious over Anno, Tosaka and Nomura (as evidenced by the ACS registry files), taken separately or in combination.

Claims 8 and 10-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with Kanbayashi, as applied to claim 1 above, further combined with Nomura.

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The rejection of claims 10 and 11 is moot in view of the cancellation of these claims without prejudice or disclaimer. The rejection of claims 8 and 12 is overcome by the amendment to claim 8.

As noted above, claim 8 has been amended to delete the recitation of formulas 3, 4 and 6-9. Anno was cited as disclosing formula (4) and Kanbayashi was cited as disclosing formulas (4) and (7)

Moreover, Anno and Kanbayashi do not disclose a phase inversion accelerator and do not suggest such solvents having a phase inversion acceleration function. Nomura does not directly suggest the combination of a phase inversion accelerator and a polyester resin, and its effect.

Applicants therefore submit that claims 8 and 12, as amended, are novel and non-obvious over Anno, Kanbayashi, and Nomura, taken separately or in combination.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with Japanese Patent 2000-81734 (JP '734). See the Derwent translation of JP '734 for cites. (Office action paragraph no. 14)

The rejection is moot in view of the cancellation of claims 1-4, 6 and 7 without prejudice or disclaimer.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura combined with JP '734. See the Derwent translation of JP '734 for cites. (Office

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action paragraph no. 15)

The rejection is moot in view of the cancellation of claims 1-4, 6 and 7 without prejudice or disclaimer.

Claims 8 and 10-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with JP '734, as applied to claim 1 above, further combined with Nomura.
(Office action paragraph no. 16)

The rejection of claims 10 and 11 is moot in view of the cancellation of these claims without prejudice or disclaimer. The rejection of claims 8 and 12 is overcome by the amendment to claim 8.

As noted above, claim 8 has been amended to delete the recitation of formulas 3, 4 and 6-9. Anno had been cited as disclosing formula (4).

Applicants therefore submit that claims 8 and 12 are novel and non-obvious over Anno, JP '734 and Nomura, taken separately or in combination.

Claims 1-4, 6-8 and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, 9-11 and 14-25 of co-pending application no. 09/791,860 in view of Tosaka as evidenced by ACS File Registry Nos. 56396-10-2, 6448-96-0, and 12225-06-8.

Claims 1-4, 6-8 and 10-12 are provisionally rejected under the judicially created

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doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, 9-11 and 14-25 of co-pending application no. 09/791,860 in view of Kanbayashi.

Claims 1-4, 6-8 and 10-12 are provisionally rejected under the judicially doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, 9-11 and 14-25 of co-pending application '860 in view of JP '734. See Derwent translation of JP '734 for cites.
(Office action paragraph no. 18)

The rejection of claims 1-4, 6, 7, 10 and 11 is moot in view of the cancellation of claims 1-4, 6, 7, 10 and 11 without prejudice or disclaimer. The rejection of claims 8 and 12 is overcome by the amendments to the claims.

In the rejections, the Examiner combines the claims of U.S.S.N. 09/791,860 with Tosaka, Kanbayashi, or JP'734. The Examiner indicates that these references provide a teaching or suggestion for formulas (3), (4), (6) and (7) in claim 1.

In the amendment to claim 8, the recitation of formulas (3), (4), (6) and (7) has been deleted. Applicants therefore submit that, as amended, claims 8 and 12 are not obvious over the claims of co-pending application no. 09/791,860 in view of the cited references.

In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the

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Examiner is requested to contact Applicants undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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